

## REMARKS

The following remarks are offered in complete response to the Office Action dated July 5, 2007. Entry of the foregoing and reexamination and reconsideration of the subject application, as amended, pursuant to and consistent with 37 C.F.R. § 111, are respectfully requested in light of the following remarks.

Applicants gratefully acknowledge the Examiner's joining claims 6-9 with group I, which is currently being examined.

Claims 1-33 are now pending in this application. Claims 10-33 have been withdrawn by the Examiner as being drawn to a non-elected invention.

Paragraph [0031] of the specification has been amended to correct the citation to the reference in the paragraph. Original paragraph [0031] cited Voorhees et al. as the authors. However Kang is the first named author and Voorhees in the last named author. The specification has been amended to correct this citation.

Claims 1-6 and 8 have been amended to delete "vitamin D analog". Claim 1 has also been amended to add the structure to each of the specific compounds listed and to correct a typographical error in the name of one of the compounds, where a bracket "]" had inadvertently been omitted. The addition of the structures is being made at the request of the Examiner. Support for these structures is found in Fig. 5 and 6 of the specification. Support for the correct nomenclature of the compound with the typographical error is found at least in claim 1 and paragraph [00124], Example 5 of the specification.

Information Disclosure Statement (IDS)

The Examiner indicated that copies of references cited in the IDS filed on 6/26/2004 were not provided and requested Applicants provide the references cited in the IDS.

Applicants respectfully submit that they did not file an IDS on 6/26/2004. An examination of the file wrapper in the USPTO PAIR system indicates that an IDS was filed on June 24, 2004 and was entered into the system on June 28, 2004. A copy of this IDS of June 24, 2004 from the PAIR system is enclosed on the following three pages. The IDS in the file wrapper is not for the instant application but rather is for application Serial Number 10/781,538. The serial number of the instant application is 10/718,538. The IDS in the file wrapper relates to a different application, by a different inventor and for a different use, as evidenced by information in the IDS. Applicants believe that the cited IDS was inadvertently placed into the wrong file wrapper at the USPTO. Applicants therefore maintain that since the cited IDS does not belong with the instant application any additional response to this requirement is moot.

Applicants request that the Examiner transfer this IDS from the file wrapper of the instant application to the file wrapper of the case to which it pertains. If this is not possible, Applicants request the Examiner note on the IDS that this IDS does not pertain to the case and was inadvertently placed in the file of the wrong application.



JPW

PATENT  
ATTORNEY DOCKET NO. 00786/376003

Certificate of Mailing: Date of Deposit: June 24, 2004

I hereby certify under 37 C.F.R. § 1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated above and is addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Colleen Coyne

Printed name of person mailing correspondence

Colleen Coyne

Signature of person mailing correspondence

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Jerrold Rosenbaum	Art Unit:	1614
Serial No.:	10/781,538	Examiner:	Not yet assigned
Filed:	February 18, 2004	Customer No.:	21559
Title:	USE OF PRAMIPEXOLE AS A TREATMENT FOR COCAINE CRAVING		

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

INFORMATION DISCLOSURE STATEMENT

Applicants submit the references listed on the enclosed Form PTO-1449.

Submission of this statement is not a representation that a search has been made, nor is the inclusion of information in this statement an admission that the information is material to patentability.

Under 35 U.S.C. § 120, this application relies on the earlier filing date of application serial number 10/088,628 which was filed on June 12, 2002. The following references listed on the PTO 1449 form were submitted to and cited by the Office in the

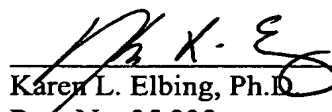
prior application and, therefore, copies of these references are not provided for this application.

This statement is being filed before the receipt of a first Office action on the merits.

If there are any charges or any credits, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,

Date: 24 June 2004

  
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Sheet 1 of 1

SUBSTITUTE FORM PTO-1449 (MODIFIED)		U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE		Attorney Docket No. 00786/376003		
INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Use several sheets if necessary)		(37 C.F.R. §1.98(b))		Serial No. 10/781,538		
				Applicant Jerrold Rosenbaum		
				Filing Date February 18, 2004		
				Group 1614		
				IDS Filed June 24, 2004		
				Customer No. 21559		
U.S. PATENTS						
Examiner's Initials	Patent Number	Issue Date	Patentee	Class	Subclass	Filing Date (If Appropriate)
	5,650,420	07/22/97	Hall et al.			
FOREIGN PATENT OR PUBLISHED FOREIGN PATENT APPLICATION						
Examiner's Initials	Document Number	Publication Date	Country or Patent Office	Class	Subclass	Translation (Yes/No)
OTHER DOCUMENTS (INCLUDING AUTHOR, TITLE, DATE, PLACE OF PUBLICATION)						
	Bayuk et al., "The effects of pramipexole on cue induced craving" 38 <sup>th</sup> Annual Meeting of American College of Neuropsychopharmacology, Abstract 51 (Dec. 1999).					
	Buydens-Branchey et al. "Buspirone attenuates withdrawal symptoms in cocaine addicts" 38 <sup>th</sup> Annual Meeting of American College of Neuropsychopharmacology, Abstract 52 (Dec. 1999).					
	Caine et al., "D <sub>3</sub> receptor test <i>in vitro</i> predicts decreased cocaine self-administration in rats" <i>NeuroReport</i> 8:2373-2377 (1997).					
	Eiler et al., "Double-blind comparison of bromocriptine and placebo in cocaine withdrawal" <i>Am. J. Drug Alcohol Abuse</i> 21:65-79 (1995).					
	Filip et al., "The role of dopamine receptor subtypes in the discriminative stimulus effects of amphetamine and cocaine in rats" <i>Pol. J. Pharmacol.</i> 49:21-30 (1997).					
	Abstract of EP 417,637 A2, Kutter et al., March 20, 1991					
EXAMINER				DATE CONSIDERED		
EXAMINER: Initial citation considered. Draw line through citation if not in conformance and not considered. Include copy of this form with the next communication to applicant.						

**Specification**

Paragraph [0031] of the specification has been amended to correct the citation to the reference in the paragraph as described above.

**35 U.S.C. §112 first paragraph, written description requirement**

Claims 1-9 have been rejected under 35 U.S.C. §112, first paragraph, as purportedly failing to comply with the written description requirement. Specifically, the claims allegedly contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

The examiner alleges that the specification does not disclose "analogue compound" of the claimed vitamin D compounds.

Applicants' have amended claims 1-6 and 8 to delete the phrase "vitamin D analog", thereby rendering this rejection moot.

Applicants request that this rejection be withdrawn as claim 1 complies with the written description requirement of 35 U.S.C. §112, first paragraph.

**Rejection under 35 U.S.C. §112 second paragraph**

Claim 1 has been rejected under 35 U.S.C. §112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The Examiner has alleged that the claim as drafted is confusing and the protective groups are not clear. The Examiner has requested Applicants draw the structure of the claimed compounds so that it

would be easier for detailed examination and to provide a better claim when published.

Applicants have amended claim 1 to include a structural diagram of the claimed compounds as requested by the Examiner.

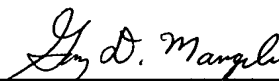
Applicants request that this rejection be withdrawn as claim 1 particularly points out and distinctly claims the subject matter which the applicant regards as the invention.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned at (703) 838-6587.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: October 5, 2007

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